

REMARKS

In response to the Office Action of July 16, 2003, claim 18 is amended to correct a minor grammatical error. No new matter is added. Claims 1-11 and 18-21 are now active in this application.

The indication that claims 6, 7 and 23 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims is acknowledged and appreciated.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103

I. Claims 1-5, 8-10 and 18-22 are rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson (USPN 6,222,538).

The rejections are respectfully traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention such that the identically claimed invention is placed into possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 200 U.S. App. LEXIS 6300, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

There is a significant difference between the claimed invention and the arrangement disclosed by Anderson that scotches the factual determination that Anderson identically describes the claimed inventions within.

Independent claim 1 requires, *inter alia*:

a controller which controls the display to display the display mode selected by the selector, and at a time the display mode on the display is changed

to one of the plurality of display modes from an another display mode different from the plurality of display modes, to display the display mode which was displayed before the display mode on the display is changed to the another display mode.

In dependent claim 18 requires, *inter alia*:

a controller which controls the display, at a time of changing the display form on the display from the display form of the second display mode to the display form included in the first display mode, to display the display form which was displayed at a time of changing the display form on the display from the display form included in the first display mode to the display form of the second display mode.

Anderson does not disclose or suggest the feature that “at a time the display mode on the display *is changed to one of the plurality of display modes from an another display mode different from the plurality of display modes, to display the display mode which was displayed before the display mode on the display is changed to the another display mode*”, as recited in claim 1, or the feature that “at a time of changing the display form on the display from the display form of the second display mode to the display form included in the first display mode, *to display the display form which was displayed at a time of changing the display form on the display from the display form included in the first display mode to the display form of the second display mode*”, as recited in claim 18.

The Examiner refers to the self-timer key 410b of FIG. 7A of Anderson, and asserts that “As suggested by the specification of Anderson, when key 410b is pressed, the LCD screen will provide some sort of visual depiction of the self-timer mode for a pre-determined amount of time (the timer setting) and once the photographic operation via self-timer is executed, the display will return[s] to the capture display mode present prior to the actuation of the soft key 410b for the self-timer.” However, anticipation, under 35 U.S.C. § 102, requires that each element of the

claim in issue be found, *either expressly described or under principles of inherency* (emphasis added), in a single prior art reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983).

With regard to the self-timer mode, Anderson discloses only that the camera is equipped with such function. There is no disclosure in Anderson about any specific display representation at the self-timer mode or the system operation thereof. Since there is no disclosure about switching the specific display representations, the above noted features recited in claims 1 and 18, are clearly not disclosed or suggested in Anderson.

The Examiner should be aware that the mere assertion by the Examiner that an element is *suggested in a specification* evinces that the element that is suggested is **NOT** expressly described in the specification. Since any specific display representation at the self-timer mode or the system operation thereof is not *expressly described* in Anderson, the only other basis to establish anticipation is that such is found *under principles of inherency*. However, for an element/step to be inherent in a reference, the missing element/step must be necessarily present, not merely probably or possibly present in the reference. See *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002).

In this regard, Applicants note that, given the fact that there is no disclosure in Anderson of any specific display representation at the self-timer mode or the system operation thereof, the self timer function of Anderson could operate differently than the manner in which the Examiner suggests it operates. More specifically, the Examiner has merely suggested a *possible* manner in which the self timer function of Anderson could operate, but has not factually established that the self timer function of Anderson **must** operate in the manner suggested. However, a possible

manner in which the self timer function can operate can not be used to establish anticipation with respect to the above noted features recited in claims 1 and 18.

The Examiner contends also that “In the playback mode of Anderson, a plurality of images may be shown in a “list” format including details of one or more of the images displayed,” referring to column 11, lines 1-33. However, the Examiner’s understanding of the disclosure at column 11, lines 1-33 of Anderson is incorrect. In this portion of Anderson, there is merely described that a plurality of image capture sequence (scripts for displaying images in a predetermined category) is listed for a user’s selection.

Thus, it appears that the Examiner does not understand what is actually disclosed in Anderson with respect to the playback mode. In addition, the correspondence found by the Examiner between the claimed invention and the disclosure of Anderson is based on some imaginary/possible display representation, not on an actual display representation disclosed in Anderson.

The above argued differences between the claimed device vis-à-vis the device of Anderson undermine the factual determination that Anderson identically describes the claimed invention within the meaning of 35 U.S.C. § 102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1-5, 8-10 and 18-22 under 35 U.S.C. § 102 for lack of novelty as evidenced by Anderson is not factually or legally viable and, hence, solicit withdrawal thereof.

II. Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Tsukahara (USPN 6,016,407).

The rejection is respectfully traversed. Claim 11 depends from claim 1 and, as claim 1 is patentable over Anderson, claim 11 is patentable over Anderson also, even when considered in view of Tsukahara.

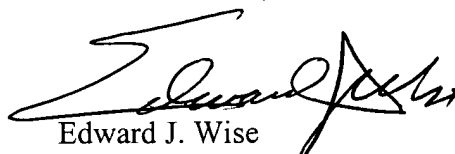
CONCLUSION

Accordingly, it is urged that the application, as now amended, is in condition for allowance. Entry of the amendment and favorable reconsideration of this application, as amended, are respectfully requested. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Edward J. Wise
Registration No. 34,523

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 EJW:dmd
Facsimile: (202) 756-8087
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